



AP.PRE.REQ

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

23616.001

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on December 20, 2005

Signature

Typed or printed name R. Lewis Gable

Application Number

09/488,107

Filed

Jan. 20, 2000

First Named Inventor

Warren E. Friss

Art Unit

3624

Examiner

Jagdish N. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
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Registration number if acting under 37 CFR 1.34

December 20, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Misuse of Non-Functional Descriptive Material Rejection:** The Examiner has held that certain recitations of Appellants' claims were Non-Functional Descriptive Material and, therefore, could not be used to distinguish for Section 102 and 103 purposes their claims from the cited prior art. 2106 MPEP IV.B.1(a) and IV.B.1(b) define respectively functional descriptive material and non-functional descriptive material. Descriptive material takes the form of a data structure per se or a program listing, music, literature, art or mere compilations of facts or data. Mere descriptive material may be used to encode a computer-readable medium, whereby the data structure defines structural and functional interrelationships between the data structure, and the computer-readable medium and the hardware components of the computer processing the data structure. At page 8, line 9 et seq. of the 6/20/05 Office Action, the Examiner held that the recitations "initially" and "set by the issuer" of claim 71 were "non-functional limitations since they are not functionally involved in the steps recited." The Appellants respectfully observe that the noted "initially" and "set by the issuer" is not descriptive material, much less either functional or non-functional descriptive material. In particular, neither of the terms "initially" or "set by the issuer" are "data structures" or "computer software" as defined in the noted portions of the MPEP. The Examiner has identified at the following pages what he deems to be descriptive materials: page 12, claim 73, and "limited number" or "uncirculated condition"; page 14, claim 77, and "initial placement"; page 19, claim 110 and "initial offering"; page 26, claim 119, and "given conditions" and "primary" and "secondary" markets; page 27, claim 123, "original purchaser" and "first and second markets;" page 30, claim 62, and "maintained in the protecting environment to keep the maintained collectibles in their uncirculated condition"; and page 33, claim 69, and "prompting such purchasers to effect selected of the following--". Appellants have carefully reviewed the descriptive material that the Examiner deems to be non-functional material as set out in the outstanding Office Action dated June 20, 2005. Appellants respectfully assert that the identified examples are not in any sense of the terms descriptive material, i.e., data structures or computer applications as defined in the identified sections of the MPEP, much less functionally non-related material as described in the noted portions of the MPEP. Therefore, Appellants respectfully request that the rejection of claims 71, 73, 77, 110, 119, 123, 162 and 69 as not being directed to descriptive material, much less non-functionally descriptive material, be withdrawn.

**Misuse of Inherency Rejection:** The Examiner's use of inherency fails to establish a prima facie record of obviousness over US Patent No. 6,266,651 of Woolston (Woolston Patent). In particular, Appellants recite in their claim 115 a method of offering for sale a collectable like a baseball card while the card is maintained at a condition until the card is encapsulated for distribution. While acknowledging that the Woolston Patent failed to disclose the step of maintaining the condition of the collectibles over a recited period of time, the Examiner found that Woolston's providing "text information concerning the card" (see col. 3, lines 61 – 67) "inherently requires maintaining the condition while the collectibles are offered for sale (see page 24, lines 40 et seq. of the 6/20/05 Office Action). The Examiner's argument is no more than a conclusory statement that fails to establish the asserted inherency. Zurko, 59 USPQ2d 1693. At page 5 of the outstanding Office Action, the Examiner notes that step b) of claim 102 of allocating selectable collectibles is inherent in view of col. 2 L 27-57. Appellents respectfully assert that the cited portion of the applied Woolston Patent is not relevant to step b) of Appellents claim 102 and is no more than a conclusory statement. Further, Appellents respectfully assert that the Examiner has not established a prima facie case of anticipation in that he admits that at least one recitation of claim 102 is not met by Woolston. The Examiner asserts that step e) of claim 77 at page 14 identifies the "condition of the card" as set out in (col. 3 L 61-66)," and thus as inherently requires that maintaining of the condition while the collectibles are offered for sale. Appellents respectfully assert that determining the collectible condition does not necessarily or inherently indicate that there will be a step or means for maintaining the condition of the collectible. The Examiner at best has merely made a conclusory statement as to maintaining the collectible condition. Appellents respectfully traverse that the statement in step d) of claim 115 (page 24) "inherently requires maintaining the condition while the collectibles are offered for sale" is taught at col. 3 L 61-66 of Woolston. Appellents have reviewed this identified portion and respectfully asserts that one skilled in the art would not associate the step of maintaining the collectibles condition with the noted portion of the Woolston reference and is no more than a conclusory statement of the missing teaching. In step a) of claim 62, the Examiner asserts that col. 9 L 66-col 10 L 32 explicitly teaches the building of a database by inputting data regarding the identity of the goods. The noted portion of Woolston is no more than a conclusory statement of the desired teaching of Woolston. Step e) of claim 71 (at page 8) asserts that the step of maintaining is inherent from the passage (at col. 2 L 44-46) which asserts

that determining the condition of the card “inherently requires maintaining the condition while the collectibles are offered for sale.” Appellents respectfully traverse this interpretation of the Woolston Patent and the use of inherency to include the step of maintaining the condition. In particular, Appellents respectfully assert that the mere determining of the condition of the collectible would logically require the maintaining of the condition. Appellents respectfully assert that this use of inherency is not in the least supported by the disclosure of Woolston, but rather such teaching is a product of hindsight knowledge of Appellents’ application. Appellents note that the Examiner has used a similar interpretation of the following claims in his use of inherency. Thus, Applicant respectfully requests that any rejection based upon this flawed use of inherency be withdrawn.

**Woolston/Bezos does not Disclose Maintaining the Collectible Condition:** Appellents respectfully traverse and request the rejection of independent claims 102, 49, 71, 77, 131, 133, 69 and 115 as being anticipated and/or obvious over Woolston whether taken by itself or in combination with Bezos. The listed claims relate to a method of managing an initial offering of collectibles of a predetermined condition and maintaining the predetermined condition at least from the initial offering for sale of the collectibles. The Examiner has rejected these claims in that he deems them to be inherent in view of that passage (col. 3 L 61-66 at page 5 L 25,) which specifies according to the Examiner the condition of the collectible and that such indication inherently requires the maintaining of the condition. As urged above, Appellents respectfully assert that such a use of an inherency is proper and does not logically flow from the cited portion of Woolston. Further, the Examiner at page 8 L 8 interprets the meaning of the term “maintaining” as “storing or safeguarding the collectibles as deemed appropriate by the entity holding the collectibles.” Appellents respectfully traverse such an interpretation of the scope of these claims in that the terms storing or safeguarding are broader than mentioning the condition and do not connote the protection and/or maintaining of the collectibles condition. Claim 77 further recites a method of selling collectibles of a predetermined condition on a primary market and on a secondary market and, further, of maintaining the condition of the collectibles during the primary market, the receiving of orders from the respective purchasers and the further offering of the collectibles for sale on the secondary market. Claim 131 recites maintaining the condition of the collectibles and, further, providing each successful purchaser the option to remove or not to remove the collectible from a protective environment. Claim 133 further

includes the step of transferring the ownership of the one collectible from a first to a second purchaser. Independent claim 69 recites a protective environment to receive and maintain the condition of an uncirculated collectible and, further, the prompting of each purchaser either to keep their purchased uncirculated collectibles in the protective environment or to offer for sale the collectibles on a secondary market.

**Woolston/Bezos Does Not Teach a Database for Purchaser:** Appellents further urge that the following, second set of claims distinguishes Woolston taken alone or in combination with Bezos: 49, 73 and 110. In claim 49, Appellents recite a method of operating a server to receive collectibles over a network and, further, to create in response to a received order an account in a purchaser history database for the potential purchaser that placed the order. Claim 73 further recites the transmission to a plurality of remote terminals a message carrying a limited number of collectibles, whereby at least one of the potential purchasers is enabled to actuate its remote terminal to transmit first and second orders to a server and, further, to process the orders to allocate at least one of the limited number of collectibles among the potential purchasers and to create for the successful purchaser a record in a memory for the collectibles. Claim 110 further recites the transmission of an initial offering statements to a potential purchaser for a predetermined time of a limited number of the collectibles for sale, wherein the initial offering also includes an indication of the condition of the collectibles.

**Woolston/Bezos Does Not Teach Sending a Message Carrying a Number and Condition of Collectibles:** Appellents further recite claim 96 to manage an initial offering of a limited number of collectibles, each being of a predetermined condition. The collectibles and their determined condition and limited number of such collectibles are stored in a memory and, further, are communicated to potential purchasers as a message offering to sell the collectibles. Appellents respectfully assert that the subject matter of claim 96 distinguishes the Woolston Patent.

**Woolston/Bezos Does Not Teach Purchasing Collectibles on a Primary Market and Selling Collectibles on a Secondary Market:** Appellents further assert that their claim 119 distinguishes Woolston. In particular, claim 119 recites a method of managing the sale of collectibles on primary and secondary markets, whereby the collectibles are offered to the potential purchasers on the primary market. The purchasers of the collectibles on the primary market are facilitated to offer for sale the purchased collectibles on the secondary market. It is

respectfully asserted that Woolston does not disclose the purchasing of collectibles on the first market and thereafter offering for sale the purchased collectibles on a second market.

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